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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,458	08/24/2006	Takehiko Sasahara	8096-1001	6825
<div>466 7590 11/04/2009</div> <div>YOUNG &amp; THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314</div>				
<div>EXAMINER</div> <div>COLEMAN, BRENDA LIBBY</div>				
<div>ART UNIT</div> <div>PAPER NUMBER</div> <div>1624</div>				
<div>NOTIFICATION DATE</div> <div>DELIVERY MODE</div> <div>11/04/2009</div> <div>ELECTRONIC</div>				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

# Office Action Summary

**Application No.**

10/590,458

**Applicant(s)**

SASAHARA ET AL.

**Examiner**

Brenda L. Coleman

**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,10-12,22-24 and 41-72 is/are pending in the application.
- 4a) Of the above claim(s) 46-48 and 64-72 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 44,45,58 and 61 is/are allowed.
- 6) ☒ Claim(s) 1,2,10-12,22-24,41-43,49-57,59,60,62 and 63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :9/10/2009; 7/31/2009; 2/25/2009; 11/24/2006; and 8/24/2006.

### **DETAILED ACTION**

Claims 1, 2, 10-12, 22-24 and 41-72 are pending in the application.

#### ***Election/Restrictions***

1. Applicant's election without traverse of Group II in the reply filed on July 31, 2009 is acknowledged.
2. Claims 46-48 and 64-72 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 31, 2009.

#### ***Information Disclosure Statement***

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 2, 10-12, 22-24, 41-45 and 49-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly

claim the subject matter which applicant regards as the invention. The following reasons apply:

- a. Claim 1 and claims dependent thereon are vague and indefinite in that it is not known what is meant by "piperidil" in the definition of the substituents on the alkyl group, alkenyl group and the alkynyl group in the definition of  $R^3$  and  $R^4$ .
- b. Claim 1 and claims dependent thereon are vague and indefinite in that it is not known what is meant by "piperidil" in the definition of the substituents on the alkyl group, alkenyl group and the alkynyl group in the definition of  $R^{5a}$ ,  $R^{6a}$  and  $R^{7a}$ .
- c. Claim 1 and claims dependent thereon are vague and indefinite in that it is not known what is meant by "piperidil" in the definition of the substituents on the alkyl group and the alkenyl group in the definition of  $R^{11}$ .
- d. Claim 2 and claims dependent thereon are vague and indefinite in that it is not known what is meant by "piperidil" in the definition of the substituents on the alkyl group, alkenyl group and the alkynyl group in the definition of  $R^{5a}$ ,  $R^{6a}$  and  $R^{7a}$ .
- e. Claim 2 and claims dependent thereon are vague and indefinite in that it is not known what is meant by "piperidil" in the definition of the substituents on the alkyl group and the alkenyl group in the definition of  $R^{11}$ .
- f. Claim 11 is a substantial duplicate of claim 10 as the only difference is a statement of intended use, which is not given material weight. Note In re Tuominen 213 USPQ 89.

- g. Claim 12 is a substantial duplicate of claim 10 as the only difference is a statement of intended use, which is not given material weight. Note In re Tuominen 213 USPQ 89.
- h. Claim 23 is a substantial duplicate of claim 22 as the only difference is a statement of intended use, which is not given material weight. Note In re Tuominen 213 USPQ 89.
- i. Claim 24 is a substantial duplicate of claim 22 as the only difference is a statement of intended use, which is not given material weight. Note In re Tuominen 213 USPQ 89.
- j. Claim 50 is a substantial duplicate of claim 49 as the only difference is a statement of intended use, which is not given material weight. Note In re Tuominen 213 USPQ 89.
- k. Claim 51 is a substantial duplicate of claim 49 as the only difference is a statement of intended use, which is not given material weight. Note In re Tuominen 213 USPQ 89.
- l. Claim 53 is a substantial duplicate of claim 52 as the only difference is a statement of intended use, which is not given material weight. Note In re Tuominen 213 USPQ 89.
- m. Claim 54 is a substantial duplicate of claim 52 as the only difference is a statement of intended use, which is not given material weight. Note In re Tuominen 213 USPQ 89.

- n. Claim 56 is a substantial duplicate of claim 55 as the only difference is a statement of intended use, which is not given material weight. Note In re Tuominen 213 USPQ 89.
- o. Claim 57 is a substantial duplicate of claim 55 as the only difference is a statement of intended use, which is not given material weight. Note In re Tuominen 213 USPQ 89.
- p. Claim 59 is a substantial duplicate of claim 58 as the only difference is a statement of intended use, which is not given material weight. Note In re Tuominen 213 USPQ 89.
- q. Claim 60 is a substantial duplicate of claim 58 as the only difference is a statement of intended use, which is not given material weight. Note In re Tuominen 213 USPQ 89.
- r. Claim 62 is a substantial duplicate of claim 61 as the only difference is a statement of intended use, which is not given material weight. Note In re Tuominen 213 USPQ 89.
- s. Claim 63 is a substantial duplicate of claim 61 as the only difference is a statement of intended use, which is not given material weight. Note In re Tuominen 213 USPQ 89.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brenda L. Coleman/  
Primary Examiner, Art Unit 1624